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10/764,153	01/24/2004	Amanda K. Bridges	2003-0535.02	8151
21972 7590 04/03/2008 LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999				
EXAMINER				
MCLEAN, NEIL R				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,153

Applicant(s)

BRIDGES ET AL.

Examiner

Neil R. McLean

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments see Remarks Made in an Amendment filed 12/28/2007, with respect to the rejection(s) of claim(s) 1-23 have been fully considered and are persuasive. However, upon further consideration, a new ground(s) of rejection is made in view of Eguchi (US 7,023,586).

Regarding Applicant's Argument:

"Saito et al. and any of the other cited references alone or in combination, fail to disclose, teach or suggest the step of generating a transmission report including an indication of success or failure of acceptance in the primary SMTP gateway of the email transmission, as recited in claim 1."

Examiner's Response:

Saito does not disclose expressly wherein said generated transmission report including an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission.

Eguchi discloses wherein said generated transmission report including an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission **(The e-mail communication over the internet has specifications defined by RFC (request for comments). According to RFC, an e-mail transmitter**

can have an optional function of receiving a return e-mail that notifies reception of the e-mail. This reception acknowledgement (return receipt) is either MDN (Message Disposition Notification) or DSN (Delivery Status Notification). MDN is set to a respective e-mail by the transmitter, and DSN is set to the mail server by a command from the transmitter. MDN notifies that a recipient of an e-mail has received (or printed or seen) the e-mail. On the other hand, DSN is a notification returned from a mail server at the most downstream stage of the network. DSN is sent back from a recipient provider that has a mail server, if the e-mail has properly reached the recipient. If the e-mail is not delivered to the recipient, a server where malfunctioning occurs issues a failure notification as described in Column 1, lines 37-53).

Saito & Eguchi are combinable because they are from the same field of endeavor of image processing; e.g., both references describe a communication network including facsimiles.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission

The suggestion/motivation for doing so would be to know if an email transmission has been received by a server so that transmission of data can be verified.

Therefore, it would have been obvious to combine Eguchi's acknowledgement (return receipt) with Saito's Internet Facsimile to obtain the invention as specified.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 5-12, 19-20, and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US 6,618,749) in view of Eguchi (US 7,023,586).

Regarding Claim 1: (Currently Amended)

Saito et al. discloses a method of using a print device (e.g., Figure 2), comprising the steps of:

transmitting (Column 3, lines 37-40) an email over a network (e.g., Internet 13 in Figure 1); and

generating a transmission report (e.g., Figure 4; Column 5, lines 20-42) at said print device, said transmission report including an indication of success or failure (Column 2, lines 27-31) of said email transmission (Column 4, lines 22-24).

Saito does not disclose expressly wherein said generated transmission report including an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission.

Eguchi discloses wherein said generated transmission report including an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission **(The e-mail communication over the internet has specifications defined by RFC (request for comments). According to RFC, an e-mail transmitter can have an optional function of receiving a return e-mail that notifies reception of the e-mail. This reception acknowledgement (return receipt) is either MDN (Message Disposition Notification) or DSN (Delivery Status Notification). MDN is set to a respective e-mail by the transmitter, and DSN is set to the mail server by a command from the transmitter. MDN notifies that a recipient of an e-mail has received (or printed or seen) the e-mail. On the other hand, DSN is a notification returned from a mail server at the most downstream stage of the network. DSN is sent back from a recipient provider that has a mail server, if the e-mail has properly reached the recipient. If the e-mail is not delivered to the recipient, a server where malfunctioning occurs issues a failure notification as described in Column 1, lines 37-53).**

Saito & Eguchi are combinable because they are from the same field of endeavor of image processing; e.g., both references describe a communication network including facsimiles.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission

The suggestion/motivation for doing so would be to know if an email transmission has been received by a server so that transmission of data can be verified.

Therefore, it would have been obvious to combine Eguchi's acknowledgement (return receipt) with Saito's Internet Facsimile to obtain the invention as specified in Claim 1.

Regarding Claim 5:

Saito et al. further discloses the method of claim 1, wherein said transmission report includes upon said failure at least one of a primary SMTP (Column 4, lines 15-18) gateway IP address, an indication of said failure (Column 2, lines 27-31), a number of tries of said transmission, and a mail server response.

Regarding Claim 6:

Saito et al. further discloses the method of claim 1, wherein said email includes an attachment (Column 7, lines 9-12).

Regarding Claim 7:

The method of claim 6, wherein said transmission report includes an image of said attachment (Saito et al. Column 7, lines 9-12).

Regarding Claim 8:

The method of claim 6, wherein said transmission report includes a image of said attachment upon a successful transmission (Saito et al.: Column 2, lines 27-31) of said

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email, and said transmission report does not include a image of said attachment upon an unsuccessful transmission (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 7, lines 9-12).

Regarding Claim 9:

Saito et al. further discloses the method of claim 6, wherein said attachment comprises one of a scan job (Scanner 26 in Figure 2, Column 4, lines 1-2) and a fax job (Fax 28 in Figure 2; Column 4, lines 3-4) associated with said email (Column 3, lines 37-40).

Regarding Claim 10:

Saito et al. further discloses the method of claim 9, wherein said transmission report comprises information relating to said attachment, including at least one of a file name, data format (Figure 7, "This message is accompanied by TIFF = Format Image Data"), and image resolution.

Regarding Claim 11:

Saito et al. further discloses the method of claim 1, wherein said generating step includes the substep of printing said transmission report (Column 3, lines 41-45) with said print device.

Regarding Claim 12:

Saito et al. further discloses the method of claim 1, wherein said transmitting step includes transmitting said email using one of said print device (e.g., Fax 11 in Figure 1) and a computer (PC 12 in Figure 1) attached to said network (Column 3, lines 37-40).

Regarding Claim 19:

Saito et al. discloses a method of using a print device (e.g., Figure 2), comprising the steps of:

transmitting an email over a network (e.g., Internet 13 in Figure 1); and
generating a transmission report (e.g., Figure 4; Column 5, lines 20-42) at said print device, said transmission report including information (Column 2, lines 27-31) pertaining to said email (Column 4, lines 22-24).

Saito does not disclose expressly wherein said generated transmission report including an indication of success or failure of acceptance at a primary SMTP gateway of said email

Eguchi discloses wherein said generated transmission report including an indication of success or failure of acceptance at a primary SMTP gateway of said email
(The e-mail communication over the internet has specifications defined by RFC (request for comments). According to RFC, an e-mail transmitter can have an optional function of receiving a return e-mail that notifies reception of the e-mail.

This reception acknowledgement (return receipt) is either MDN (Message Disposition Notification) or DSN (Delivery Status Notification). MDN is set to a respective e-mail by the transmitter, and DSN is set to the mail server by a command from the transmitter. MDN notifies that a recipient of an e-mail has received (or printed or seen) the e-mail. On the other hand, DSN is a notification returned from a mail server at the most downstream stage of the network. DSN is sent back from a recipient provider that has a mail server, if the e-mail has properly reached the recipient. If the e-mail is not delivered to the recipient, a server where malfunctioning occurs issues a failure notification as described in Column 1, lines 37-53).

Saito & Eguchi are combinable because they are from the same field of endeavor of image processing; e.g., both references describe a communication network including facsimiles.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include an indication of success or failure of acceptance at a primary SMTP gateway of said email transmission

The suggestion/motivation for doing so would be to know if an email transmission has been received by a server so that transmission of data can be verified.

Therefore, it would have been obvious to combine Eguchi's acknowledgement (return receipt) with Saito's Internet Facsimile to obtain the invention as specified in Claim 19

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Regarding Claim 20:

Saito et al. further discloses the method of claim 19, wherein said transmission report includes an indication of success or failure (Column 2, lines 27-31) of said email transmission.

Regarding Claim 21:

The method of claim 20, wherein said transmission report includes a image associated with said email upon a successful transmission of said email (Column 2, lines 27-31), and said transmission report does not include a image associated with said email upon a failure (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 6, lines 7-13).

Regarding Claim 22:

Saito et al. further discloses the method of claim 19, wherein said automatically generating step includes the substep of printing said transmission report with said print device (Column 3, lines 41-45).

Regarding Claim 23:

Saito et al. further discloses the method of claim 19, wherein said transmitting step includes transmitting said email using one of said print device (e.g., Figure 2) and a computer (PC 12 in Figure 1) attached to said network (Column 3, lines 37-40).

4. Claims 2-4, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito and Eguchi as applied to claim 1 above, and further in view of Irlam et al. (6,650,890).

Regarding Claim 2:

Saito et al. discloses the method of claim 1, wherein said transmission report includes an image associated with said email upon a successful transmission of said email (Column 2, lines 27-31), and said transmission report does not include an image associated with said email upon an unsuccessful transmission (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 7, lines 9-12).

Saito et al. does not disclose expressly where the transmission report includes a thumbnail image.

Irlam et al. in the same field of endeavor of displaying graphical information, discloses a thumbnail image to identify a file (Column 5, lines 48-57; Column 6, lines 55-59).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a thumbnail image to represent a files contents.

The suggestion/motivation for doing so is to reduce a significant part of an image instead of the full size and still be recognizable. It offers the viewer an indication of what is contained in the image.

Therefore, it would have been obvious to combine Irlam et al.'s thumbnail image representation with the internet fax and email method of Saito et al. to obtain the invention as specified in Claim 2.

Regarding Claim 3:

The method of claim 2, wherein said image comprises an image associated with said email (Saito et al.; Column 7, lines 9-12).

Regarding Claim 4:

The method of claim 3, wherein said image comprises one of a scan job (Saito et al.: Scanner 26 in Figure 2, Column 4, lines 1-2) and a fax job (Fax 28 in Figure 2; Column 4, lines 3-4) associated with said email (Column 3, lines 37-40).

Regarding Claim 13:

Saito et al. discloses a method of using a print device (e.g., Figure 2), comprising the steps of:

transmitting an email (Column 3, lines 37-40); and
generating a transmission report (e.g., Figure 4) at said print device, said transmission report including an image associated with said email upon a successful

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transmission (Column 2, lines 27-31) of said email, and said transmission report not including an image associated with said email upon an unsuccessful transmission (The browser code or device which enables the client computer 12 in Figure 1 to not transmit a print request to the printer) of said email (Column 6, lines 7-13).

Saito et al. does not disclose expressly where the transmission report includes a thumbnail image.

Irlam et al. in the same field of endeavor of displaying graphical information, discloses a thumbnail image to identify a file (Column 5, lines 48-57; Column 6, lines 55-59).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a thumbnail image to represent a files contents.

The suggestion/motivation for doing so is to reduce a significant part of an image instead of the full size and still maintain recognizability. It offers the viewer an indication of what is contained in the image.

Therefore, it would have been obvious to combine Irlam et al.'s thumbnail image representation with the internet fax and email method of Saito et al. to obtain the invention as specified in Claim 13.

Regarding Claim 14:

The method of claim 13, wherein said thumbnail image comprises an image associated with said email (Saito et al.; Column 7, lines 9-12).

Regarding Claim 15:

The method of claim 14, wherein said image comprises one of a scan job (Saito et al.: Scanner 26 in Figure 2, Column 4, lines 1-2) and a fax job (Fax 28 in Figure 2; Column 4, lines 3-4) associated with said email (Column 3, lines 37-40).

Regarding Claim 16:

The method of claim 15, wherein said transmission report includes at least one image associated with said email upon a successful transmission (Saito et al.; Column 2, lines 27-31) of said email, each said thumbnail image corresponding to a different page of said scan job or fax job.

Regarding Claim 17:

The method of claim 13, wherein said generating step includes the substep of printing said transmission report with said print device (Saito et al.; Column 3, lines 41-45).

Regarding Claim 18:

The method of claim 13, wherein said transmitting step includes transmitting said email using one of said print device (Saito et al.: Fax 11 in Figure 1) and a computer (PC 12 in Figure 1) attached to said network (Col 3, lines 37-40).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Matsushima (US 7,019,860) discloses a method of and an apparatus for forming an image and capable of collecting information via the Internet and printing the collected information, and a computer program for making a computer execute this method.
6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. McLean whose telephone number is (571)270-1679. The examiner can normally be reached on Monday through Friday 7:30AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571.272.7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Neil R. McLean/
Examiner, Art Unit 2625
03/06/2008

/Gabriel I Garcia/
Acting SPE of Art Unit 2625